

**REMARKS**

Reconsideration of the application is respectfully requested. Claims 1 and 6 have been amended. Claims 13-22 have been added. No claims have been cancelled. After amendment, claims 1-22 are pending. Applicant respectfully submits that no new matter has been added.

**CLAIM REJECTIONS**

**Rejection under 35 U.S.C. § 102(b)**

The Office Action has rejected claims 6, 7 and 9 under 35 U.S.C. § 102(b), as being anticipated by Lammers. Applicant respectfully traverses this rejection. Lammers does not teach or suggest the use of a plunger that strikes a fastener such as a nail or a staple. Lammers only teaches the use of a structure that can move a contact from an “on” position to an “off” position. In contrast, claims 6, 7 and 9 all require a plunger that can strike a fastener such as a nail or a staple. Since Lammers is missing limitations present in claims 6, 7 and 9, it cannot anticipate these claims.

**Rejection under 35 U.S.C. § 103(a)**

The Office Action has rejected claims 1, 2 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Lammers in view of Murray. Applicant respectfully traverses this rejection. Neither Lammers nor Murray teach or suggest the use of a plunger that strikes a fastener such as a nail or a staple. As discussed above, Lammers only teaches the use of a structure that can move a contact from an “on” position to an “off” position. It is not proper to reject claims under 35 U.S.C. § 103 where the prior art relied upon is missing limitations present in the claims. See e.g., M.P.E.P. 706.02(j) (“Finally, the prior art reference (or references when combined) must

teach or suggest all of the claim limitations.”). Thus, Applicant respectfully submits that claims 1-2 and 10 are patentable over Lammers in view of Murray.

In addition to the fact that Lammers and Murray do not teach all the limitations required by the claims, Applicant also notes that neither Lammers nor Murray are in the same field as the present application. Therefore, Lammers and Murray are in nonanalogous arts and are not available as prior art. The present claims are directed to a “power tool” used for driving fastening devices such as nails, staples, etc. into a work piece. In contrast, Lammers is directed to a device that moves an actuator between an “off” position and an “on” position, i.e., an electrical switch. An electrical switch is not a power tool used to drive fasteners. Similarly, Murray is directed to a circuit breaker, which is also not a power tool used to drive fasteners. Persons having ordinary skill in the power tool arts would not look to the electrical switch or circuit breaker arts to solve the problems faced therein. See e.g., M.P.E.P. 2141.01(a).

### **ALLOWED SUBJECT MATTER**

The Office Action has indicated that claims 3-5, 8, 11 and 12 would be allowable if rewritten in independent form. Based on the forgoing arguments, Applicant respectfully submits that claims 3-5, 8, 11 and 12 are allowable without being rewritten since they are dependent on allowable base claims. However, Applicant has added new independent claims 17-22 which incorporate all the limitations of claims 3-5, 8, 11 and 12 and of the claims from which they depend. Applicant respectfully submits that claims 17-22 are in condition for allowance, which is respectfully requested.

**CONCLUSION**

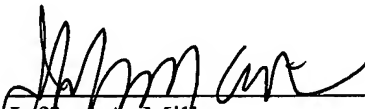
In view of the foregoing, Applicant respectfully submits that the present application is in condition for allowance, which is respectfully requested. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (650) 614-7400. If there are any additional charges, please charge Deposit Account No. 15-0665.

Respectfully submitted,

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: October 21, 2004\_\_\_\_\_

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